



Docket No. 57005-A-PCT-US/JPW/AUM/NFM

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Robert J. Winchester, et al.
Serial No.: 09/773,876 Examiner: Ron Schwadron
Filed : January 31, 2001 Group Art Unit: 1644
For : USE OF INHIBITORS OF THE ACTIVATION OF CXCR4
RECEPTOR BY SDF-1 IN TREATING RHEUMATOID
ARTHRITIS

1185 Avenue of the Americas
New York, New York 10036
June 19, 2002

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Hon. Commissioner of Patents
Washington, D.C. 20231

SIR:

**COMMUNICATION IN RESPONSE TO JANUARY 25, 2002 RESTRICTION
REQUIREMENT AND PETITION FOR FOUR-MONTH EXTENSION OF TIME**

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ORIGINALLY FILED**

This Communication is submitted in response to the Restriction Requirement issued January 25, 2002 in connection with the above-identified application. A response to the January 25, 2002 Office Action was originally due February 25, 2002. Applicants hereby petition for a four-month extension of time for responding. The fee for a four-month extension is SEVEN HUNDRED AND TWENTY DOLLARS (\$720.00) for a small entity, and a check for this amount is enclosed herewith. A response is now due June 25, 2002. Accordingly, this Communication is being timely filed.

Claims 1-17 are pending in the subject application. In the Restriction Requirement, the Examiner required restriction to one of the following allegedly distinct inventions as follows:

- I. Claims 1-6, drawn to a method of treatment;
- II. Claims 7-12, 16 and 17, drawn to a composition; and
- III. Claims 13-15, drawn to an assay method.

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In response, applicants hereby elect with traverse the invention of group III, claims 13-15, for prosecution at this time.

REMARKS

Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement set forth in the January 25, 2002 Office Action. Under 35 U.S.C. §121, restriction may be required if two or more independent and distinct inventions are claimed in one application. Under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden.

The inventions of groups I-III are not independent. Under M.P.E.P. §802.01, "independent" means there is no disclosed relationship between the subject matter claimed. The inventions of groups I-III relate to agents that inhibit the activation of CXCR4 receptor by SDF-1 in the treatment of rheumatoid arthritis. Applicants therefore maintain that the inventions of groups I-III are not independent and restriction is not proper.

Furthermore, under M.P.E.P. §803, the Examiner must examine the application on the merits if examination can be made without serious burden, even if the application would include claims to distinct or independent inventions. That is, there are two criteria for a proper requirement for restriction: (1) the invention must be independent and distinct, and (2) there must be a serious burden on the Examiner if restriction is not required. Applicants respectfully submit that there would not be a serious burden on the Examiner if restriction were not required, because a search of the prior art relevant to the non-elected groups would not require a serious burden once the prior art relevant to the elected group has been identified.